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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/438,516	11/12/1999	KIM B. ROBERTS	10799ROUS01U	9470

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EXAMINER

JONES, PRENELL P

ART UNIT	PAPER NUMBER
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2667

DATE MAILED: 09/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/438,516

Applicant(s)

Roberts et al

Examiner

Prenell Jones

Art Unit

2667

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on May 29, 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above, claim(s) 12 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 10, 11, and 13-33 is/are allowed.
- 6) ☒ Claim(s) 1, 3, 5, 6, 8, and 9 is/are rejected.
- 7) ☒ Claim(s) 2, 4, and 7 is/are objected to.
- 8) ☐ Claims are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

Art Unit: 2667

Response to Arguments

1. Applicant's arguments with respect to claims 1-33 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 U.S.C. § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1, 3, 5, 6, 8 and 9 are rejected under 35 U.S.C. 102(e) as being anticipated by Hershey et al.

Art Unit: 2667

Regarding claims 1, 3, 5, 6, 8 and 9, Hershey discloses synchronization and control in a telecommunication adj system that includes (col. 1, line 16-54, col. 6, line 1-8) transmitting in a high speed network , transmission of multi-protocol signals associated with contemporary systems (col. 4, line 61-67, col. 5, line 27-46) FPGA (programmable link termination/programmable link instigation) which provides dynamic configuration of network in accordance with performance parameters and configuration of programmable device depends on protocol technology, and Hershey further discloses (Fig. 2, col. 5, line 13-61) a recovery circuit (34) for extracting data clock and circuits for extracting data signals (36, 130a).

Allowable Subject Matter

4. Claims 2, 4 and 7 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Regarding claims 2 and 4, the limitation "PLT translates said user signal to a data signal whenever said rate R. corresponds to a provisioned first protocol and passes said user signal unchanged whenever said rate R. in not recognized by processing unit" is absent from the art.

Regarding claim 7, the limitation, "set performance parameters includes a previous section fail indicator" is absent from the art.

Art Unit: 2667

5. Claims 10, 11 and 13-33 are allowed over prior art.
6. The following is a statement of reasons for the indication of allowable subject matter: As indicated in the previous office action claims 18-22 contain allowable subject matter. Applicant has canceled claim 12 and amended claim 10 to include the allowed subject matter of previously objected to claim 12 which is "reverse mapping unit for rearranging the bits of a container of a second protocol into data signal of first protocol", whereby making claim 10 allowable, along with dependent claims 11 and 13-17. Regarding newly added claims 23-33, Applicant has added the previously indicated allowable subject matter of claims 2, 4 and 7 to independent claims 23 and 29, therefore, claims 23-33 are allowed.

Regarding claim 18, the limitation, "detecting the rate (R.) of a continuous digital signal and determining a first protocol corresponding to said rate (R.), translating said set of performance parameters from said first protocol to a second protocol characterizing said container signal and providing said translated set into said container signal" is absent from the art. Claims 19-22 depend on claim 18, therefore, claims 19-22 are allowed as well.

Regarding claims 23 and 29, the limitation, "PLT translates said user signal to a data signal whenever said rate R. corresponds to a provisioned first protocol and passes said user signal unchanged whenever said rate R. is not recognized by processing unit" is absent from the art.

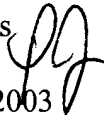
Art Unit: 2667

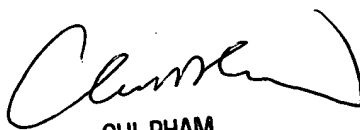
Claims 24-28 and 30-33 depend on claims 23 and 29, therefore, claims 24-28 and 30-33 are allowed as well.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Prenell Jones whose telephone number is (703) 305-0630. The examiner can normally be reached on Monday thru Friday from 9:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chi Pham, can be reached on (703) 305-4378. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9314.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Prenell Jones 
August 26, 2003


CHI PHAM
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600 9/26/03